

## **REMARKS/ARGUMENTS**

The Applicants have reviewed the final Office Action dated July 19, 2006 and submit the following remarks. Claims 11-23 are pending in this application. Reexamination and reconsideration of this application is requested.

### **Finality of Office Action is Improper**

The Applicants assert that the final status of the currently pending office action is improper. The Applicants responded to the non-final office action dated July 19, 2006, with a response on November 20, 2006 that made no amendments to the subject application. In response to the Applicants remarks and not necessitated by Applicants' amendments, the Examiner rejected all pending claims under a new ground of rejection based upon a newly cited reference and incorrectly made the office action final. See, MPEP §706.07(a). The Applicants therefore submit that the finality of this office action should be withdrawn and, since no amendments are submitted with this response, a new, non-final office action should be issued.

### **Newly Cited Reference and Present Application are**

#### **Jointly Owned and Commonly Assigned**

All pending claims have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro (US 5,705,980) in view of Cao et al (US 6,529,136) (hereinafter "Cao").

**The presently claimed invention of the subject patent application and the subject matter disclosed by the Cao reference were both, at the time that the invention was made, were owned by, or were subject to an obligation of assignment to, the same entity, namely International Business Machines Corporation of Armonk, NY. See, MPEP §706.02(1)(2)(II).**

As evidence of this common ownership and obligation of assignment, the Applicants are attaching to this response a copy of the Patent Assignment for the Cao

reference, which is recorded at reel/frame 011580/0860 and was recorded on February 28, 2001. In fact, two inventors of the subject application are inventors of the Cao reference. As shown on the attached assignment record, the Applicants point out that the Cao reference was first published on January 30, 2003, after the filing date of the subject patent application. The Cao reference therefore only qualifies as a prior art reference under 35 U.S.C. §102(e).

The Applicants assert that 35 U.S.C §103(c)(1) disqualifies the Cao reference from this application. See, MPEP §706(I)(1)(I).

### **Claim Rejections - under 35 USC § 103**

The Examiner rejected Claims 11-23 under 35 U.S.C. 103(a) as being unpatentable over Shapiro (US 5,705,980) in view of Cao et al (US 6,529,136).

As noted above, the Cao reference is not a proper reference to cite against this application because the claimed invention was commonly owned by or subject to an obligation of assignment, at the time of the invention, with the subject matter of the Cao reference to International Business Machines.

With regards to independent claims 11 and 16, the Applicants note the Examiner's assertion that Shapiro fails to disclose "comparing each of the distances to at least one distance threshold stored within a list of preferences stored in a profile database in association with the first wireless communications device." Office Action dated August 10, 2007, page 2, 5<sup>th</sup> paragraph. Since the Cao reference is disqualified under 35 U.S.C. §103(c)(1), the Applicants assert that the presently claimed invention distinguishes over the cited prior art references for at least this reason.

The Applicants further reassert their arguments regarding the lack of teaching by the Shapiro reference of several other claimed limitations, including "sending, to the first wireless communications device, the respective location and an identifier of each wireless

communications device within the set.” See, Response filed November 20, 2006, page 3, first full paragraph. For convenience, those remarks are repeated below:

With further regards to claims 11 and 16, the Applicants traverse the Examiner’s assertion that the Shapiro reference teaches “sending, to the first wireless communications device, the respective location and an identifier of each wireless communications device within the set.” Office Action dated July 19, 2006, section 4, page 2, last paragraph, (and repeated in Office Action dated August 10, 2007, page 2, fourth paragraph) citing FIG. 1, col. 4, lines 31-67, and col. 6, line 29 - col. 7, line 30. In considering the claimed invention “as a whole,” the first limitation must also be considered. The first limitation specifies “computing distances between a location of a first wireless communications device and a respective location of each of the at least one other wireless communications device.” The processing disclosed by the Shapiro reference clearly operates to determine distances between an “alarm unit 30” and the units of security officers in a protected area. See, Shapiro, column 6, lines 48-50, column 7, lines 13-19 and column 7, lines 39-45. Shapiro never teaches or suggests determining distances between the “security officers” (or their paging units 40).

The Applicants therefore assert it is clear that the “security officer’s” paging unit is not able to be analogized to the “first wireless communications device” of the claimed invention. The Applicants assert that the “first wireless communications device” of the claimed invention is only able to correspond to, at best, the “alarm unit 30” of Shapiro.

The Shapiro reference never teaches sending “the respective location and an identifier of each wireless communications device within the set” to the alarm unit 30. This information is only sent to the security officers. See, Shapiro, column 7, lines 22-29. Because the alarm unit 30 of Shapiro is the only element that might be analogized to the “first wireless communications device” of the presently claimed invention, the Applicants assert that the Shapiro reference does not teach the “sending” limitation of claims 11 and 16, particularly when the invention is considered “as a whole.”

### Rejection of Claims 19 and 20

The Applicants also reassert their arguments from their last response with regards to dependent claims 19 and 20 and the failure of the Shapiro reference to teach the limitations of claims 19 and 20. Response dated November 20, 2006, page 5, first paragraph through page 8, first paragraph.

In summary with regards to claim 19, the Examiner cites the PROM 94 as disclosing “that the respective location of each of at least one other wireless communication device is stored in a location database.” Office Action dated August 10, 2007, page 4, 2<sup>nd</sup> paragraph. Shapiro teaches that officers’ identities, and optionally the person’s image, are stored in PROM 94. Shapiro, column 4, lines 24-32. The identities of officers assigned to an area are also stored in the PROM 94. Shapiro, column 4, lines 35-38.

The Applicants assert that Shapiro fails to teach storing locations of any type in the PROM 94. Shapiro follows the description of information stored in the PROM 94 by stating that information relating to a person’s location and identity are communicated to the paging facility when sending an emergency signal, but never states that the person’s location is stored in the PROM 94. Location information is determined in real time by the system of Shapiro as part of sending an emergency signal. Shapiro, column 6, lines 28-67. The Applicants assert that the system of Shapiro never stores wireless device locations.

In summary, with regards to claim 20, the Applicants assert that the Examiner’s apparent analog of “the set” of claim 11 to “the nearest security officer” of Shapiro is even more inappropriate in the context of claim 20 and cannot support the Examiner’s rejection of claim 20. See, Response dated November 20, 2007, page 6, first paragraph through page 7, first paragraph. The Applicants further assert that the Shapiro reference

fails teach initiating communications between an “alarm unit 30” and “the selected wireless communications device” within the meaning of a “selected wireless device” as defined by claim 20, when considered as a whole and considering the other limitations of claims 20 and 11, from which claim 20 depends. The Applicants refer to their remarks concerning these limitations in their response of November 20, 2006, page 7, second full paragraph.

### **Conclusion**

The foregoing is submitted as full and complete response to the Official Action mailed August 10, 2007, and it is submitted that Claims 11-23 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 11-23 is earnestly solicited.

**If the Examiner believes that there are any informalities that can be corrected by Examiner’s amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.**

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: October 10, 2007

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